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OFFICE OF PETITIONS

In re Application of
Morano et al.
Application No. 10/689,009
Patent No. 6,978,908
Filed: Filed October 20, 2003
Attorney Docket No.B-33345P2/GER

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: DECISION GRANTING PETITION
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This decision is in response to Applicants' "Petition for patent term adjustment pursuant to 37 CFR 1.705(d)" timely¹ filed on February 10, 2005 requesting that the Patent Term Adjustment be adjusted from a determination of 36 days to a determination of eighty-five (85) days.

Applicants' petition is **GRANTED**. The Office will *sua sponte* issue a certificate of correction reflecting an adjustment of 85days rather than the 36 day amount printed on the front of the patent. The Office will also adjust the PTA calculation reflected in PAIR to reflect this decision.

Applicants argue that the Office erred in asserting an applicant delay of forty-nine (49) days for the request for acknowledgment of an IDS submitted on May 20, 2005. Applicants assert that it is a comment on the notice of allowability and therefore should not be considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR 1.704(c)(10).

Applicants have also acknowledged that a terminal disclaimer was filed in the application.

Applicants' argument have been considered. The Office agrees with applicants' assertion that the submission of the request for the IDS acknowledgment after the mail date of the notice of allowance is not considered a failure to engage in reasonable efforts to conclude prosecution of the application in this particular application. The Office notes that applicants submitted the IDS on 5/20/2005 and the Office allowed the case on 8/8/2005 without including the acknowledged IDS with the mailing of the notice of allowance. Accordingly, the Office finds that applicants would not have had an opportunity to bring this to the attention of the Office prior to the mail

¹Patent Issue on December 27, 2005.

Application No. 10/689,009

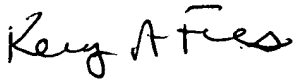
date of the notice of allowance.²

As for the submission of a terminal disclaimer, the Office notes that the Office no longer determines the expiration date of the patent. Accordingly, the Office provides the following notice on the front page of the patent: **Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S. C. 154(b) by – days.** Applicants will have to make the determination of whether the terminal disclaimer will prevent applicants from extending the 20-year term by the additional PTA days.

After review of this decision, this application will be forwarded to the certificate of correction branch for a prompt issuance of a certificate of correction.

The Office acknowledges the receipt of \$200.00 for the application for patent term adjustment (petition). No additional fees are required by the Office.

Any questions concerning the issuance of this patent should be directed to Kery A. Fries, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757



Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

cc: Adjusted Pair Calculation
Draft Certificate of Correction

²The Office makes a distinction between the present fact scenario and a scenario where applicants submitted the IDS on filing but did not ask for IDS acknowledgment until after the notice of allowance. Applicants in the second scenario would have had an opportunity to bring this to the Office's attention prior to the notice of allowance.